



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,766	02/15/2001	Tong S. Chen	A34003	2273

21003 7590 01/29/2004

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HANNE, SARA M

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,766

Applicant(s)

CHEN ET AL.

Examiner

Sara M Hanne

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 1-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "denotation of the volume control program" and the "tragbar" of Claims 2-7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1-19 are objected to because of the following informalities: the term "automatic" should be recited as "automatically" to be grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "tragbar" is not defined by the specification nor is it common to one of ordinary

skill in the art as recited in Claim 2-4 and 6. Claims 5 and 7 depend upon Claim 4 and are rejected upon this dependency.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, "whether present in a tragbar" in claim 2.

8. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "tragbar" in claims 2-4 and 6 is used by the claims, while the meaning of the term is not defined in the English dictionary nor illustrated in the specification. The term is indefinite because the specification does not clearly define the term.

9. Clarification and/or correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al., US Patent 5428730.

In reference to Claim 1, Baker et al. teaches a method for automatically obtaining the ID number for items of a volume control program by turning the program on (audio control panel), detecting an item and calculating it's ID number ("In response to a successful execution of the above code, a device ID is obtained", Column 10, lines 35-36).

In accordance with Claim 8, Baker et al. further teaches a method for reading a described message of an item and determining whether it exists in the volume control plane. ("whether or not said MMD has a controllable function corresponding to the control function of each controller", Column 13, Claim 5).

In accordance with Claims 9 and 15, Baker teaches the method of calculating the ID number of that item and calculating the ID of another item ("A complete audio control would cause a query of the device for all of the components", Column 11, lines 30-32).

In accordance with Claim 10, Baker et al. further teaches the item of Claim 8 to not exist in the volume control plane and therefore halting the process ("disable said controllers", Column 13, Claim 5).

In accordance with Claim 11, Baker et al. teaches a method for setting the ID number of the item ("enable said controllers", Column 13, Claim 5) with reference to 'nID' ('ID' as seen in the code of Column 11).

In accordance with Claim 12, Baker et al. teaches a method for setting the ID number of the volume item ("ID_VOLUME", Column 11, Line 13).

In accordance with Claim 13, Baker et al. teaches a method for setting the ID number of the left-right sound track item ("ID_BALANCE", Column 11, Line 14).

In accordance with Claim 14, Baker et al. teaches a method for setting the ID number of the muteness item ("ID_MUTE", Column 11, Line 10).

In further accordance with Claims 12-14, the difference between Baker and the claims is that the claims use a reference numbers attached to their ID number as their variable name rather than their corresponding title following their ID. However, changing the variable name does not have a disclosed purpose nor does changing their title disclosed to overcome any deficiencies in the prior art. As such, the variable title may have chosen in a number of ways, such as using reference letters, title abbreviations, or an array. Absent any evidence of criticality or unexpected results, Applicant's recitation of reference numbers to distinguish the variables in claim 12-14 would have been obvious to one of ordinary skill in the art at the time the invention was made.

In accordance with Claim 16, Baker et al. further teaches the use of MIDI as the detected item ("Such devices include ... a musical instrument digitizing interface", Column 3, lines 44-46).

In accordance with Claim 17, Baker et al. teaches a method for the another item to be volume item of the control program ("ID_VOLUME", Column 11, Line 13).

In accordance with Claim 18, Baker et al. teaches a method for the another item to be the left-right sound track item ("ID_BALANCE", Column 11, Line 14).

In accordance with Claim 19, Baker et al. teaches a method for the another item to be the muteness item of the track ("ID_MUTE", Column 11, Line 10).

Conclusion

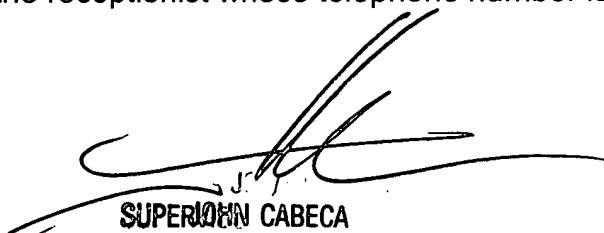
12. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach volume control systems with similar interfaces

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is N/A.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

smh



SUPERIOR CABECA
SUPERIOR PATENT EXAMINER
TECHNOLOGY CENTER 2100